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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,064	12/03/2004	Luc Moens	2004-1911A	8726

513 7590 05/15/2008

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WASHINGTON, DC 20006-1021

EXAMINER	
TOSCANO, ALICIA	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
05/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,064	MOENS ET AL.	
	Examiner	Art Unit	
	Alicia M. Toscano	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 13-21, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moens (US 5397641) in view of Kaplan (US 587192) and Barkac (US 6191225).

Elements of this rejection are as set forth in the action dated 6/11/07 and 12/18/07. Applicant amends claim 13 to include the requirement of a gloss level of between 10 and 70.

Regarding newly amended claim 13: Moens discloses thermosetting powder coatings having a high gloss value and exemplifies the gloss in the Examples to be values greater than 80. There is no disclosure of Moens as to what range "high" encompasses and as such it is unclear to the Examiner why, when the compositional elements are met, there is a discrepancy in the gloss values between Moens and Applicant. It seems that the "high" range would encompass the 10-70 gloss range of Applicant's claims since the compositional elements are met. Since all combinations of polyester, acrylic and curing agent apparently do not result in the gloss value of Applicant's claims, as evidenced by Moens, the Examiner requests a showing of how one of ordinary skill would be enabled to make Applicant's invention with low gloss without undue experimentation. As it stands Applicant's disclosure and claims are

drawn to any combination of elements which meet the wt%, monomer mole% and MW requirements of the claims and said combination, for reasons unknown to the Examiner, sometimes results in low gloss.

Additionally, Moens, Kaplan and Barkac include elements as set forth previously. Hoebeke discloses processes for preparing powdered thermosetting compositions with matte finish. Said compositions comprise a carboxyl functional polyester (similar in monomer components, acid functionality and MW to both Moens and Applicant's claims) and a glycidyl containing acrylic copolymer (similar in monomer components, functionality and MW to both Moens and Applicant's claims). Hoebeke discloses that matte finishes can be formed by controlling various aspects of the carboxyl functional polymer and glycidyl functional acrylic copolymer. See Column 4 lines 26-31, by controlling the branching and the acid number of the carboxyl polyester one can have a gloss or matte finish, likewise see Column 5 lines 54-Column 6 line 8, by controlling the Mn and the monomer makeup of the glycidyl functional acrylic copolymer one can also control the resulting powder coating finish. Hoebeke discloses that said makeup is critical for matte finish and in order to produce a matte finish over a gloss finish one must have a preponderant amount of methyl methacrylate, and less than 30 wt% glycidyl acrylate or methacrylate. The monomeric makeup has thusly been shown to be a result effective variable wherein certain ranges of said monomers will result in matte over gloss finishes. Example 15 of Moens discloses an example of the monomeric makeup the glycidyl functional acrylic copolymer used to form the glossy product of the Examples. Said Example is in accordance with said teachings of Hoebeke since the

monomeric makeup is outside the ranges taught by Hoebeke and results in a glossy finish.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use in Moens the monomeric makeup of the glycidyl functional acrylic copolymer, as taught by Hoebeke, in order to form a matte finish. As such the new limitation is met.

2. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moens (US 5397641), Hoebeke (US 5525370), Kaplan (US 587192) and Barkac (US 6191225 in further view of Kaplan (US 6313234).

This rejection is as set forth in the action dated 6/11/07 and 12/18/07, the preamble amended to include Hoebeke.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moens, Hoebeke (US 5525370), Kaplan '192 and Barkac in further view of Hoebeke.

This rejection is as set forth in the action dated 6/11/07 and 12/18/07, the preamble amended to include Hoebeke. The rejection is separated from Moens, Hoebeke, Kaplan and Barkac above for ease and clarity of the rejections.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moens, Hoebeke, Kaplan '192 and Barkac in further view of Knoops (WO 02055620).

This rejection is as set forth in the action dated 6/11/07 and 12/18/07, the preamble amended to include Hoebeke.

Conclusion

Response to Amendment

5. Applicant's amendment with respect to claims 13-26 have been considered but are moot in view of the new ground(s) of rejection. Applicant put forth further arguments in the remarks submitted 11/13/07 which have been addressed in the action dated 12/18/07, see pages 3-6 of said action. Applicant has offered no further arguments and only submits that the amendment previously set forth was not complete. New grounds of rejection as set forth above in light of this new amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is (571)272-2451. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796